UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,935	09/02/1999	TADAMITSU MIYAWAKI	104144	4667

25944 7590 11/04/2002

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER	
HAYES, JOHN W	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n No.	Applicant(s)	
	09/388,935	MIYAWAKI ET AL.	
	Examiner	Art Unit	
	John W Hayes	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-8 and 11-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-8 and 11-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 August 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 September 2002 has been entered.

Status of Claims

2. Claims 2-3 and 9-10 have been canceled in the after final amendment filed 13 August 2002. According to MPEP 706.07(h)(III)(D), any previously filed unentered amendments, amendments filed with the RCE, and any amendments filed prior to the mailing of the next Office Action (After the RCE) will normally be entered. Absent specific instructions for entry, all amendments filed as of the date the RCE is filed are entered in the order in which they were filed. Thus, since applicant did not include any specific instructions with regard to the after final amendment filed 13 August 2002, it was entered.

Drawings

3. The corrected or substitute drawings were received on 13 August 2002. These drawings are approved by the Draftsperson.

Response to Arguments

4. Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 5-7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon, U.S. Patent No. 5,727,065 in view of Civanlar, U.S. Patent No. 6,005,935.

As per **Claim 1**, Dillon discloses a contents distribution method for distributing digitized contents to plural users comprising:

- encrypting and distributing contents to plural users (Col. 1 line 65-Col. 2 line 7; Col. 6, lines 57-62),
- selecting by a user at least one of the encrypted content from a catalog (Col. 4, lines 5-20)
- decoding the encrypted contents and utilizing thereof by a user (Col. 2, lines 10-15; Col. 4, lines 12-18; Col. 6, lines 60-67; Col. 9 line 65-Col. 10 line 6), and
- executing accounting to the user according to said utilized contents (Col. 4, lines 15-20; Col. 5, lines 43-50; Col. 6, lines 19-24; Col. 7, lines 26-38; Col. 8, lines 28-43).

Dillon, however, fails to explicitly disclose that the encrypted contents are first distributed to users and wherein the users can then select at least one of the encrypted content from the distributed contents. Dillon discloses that a catalog of available contents is distributed to the plural users and further wherein the users can then select the content that they wish to receive. However, It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Dillon and distribute the available contents to the user and further allow the user to select the contents he/she is interested in after reception of the contents. Dillon teaches that this method is not necessary since it would waste resources by requiring the user to receive content not of interest. The motivation would be

to allow the user to determine which content he/she wishes to receive and charging the user for only the content that he/she receives without wasting resources by requiring the user to receive content not of interest (Col. 11 line 65-Col. 12 line 5).

Dillon further fails to explicitly disclose that the content is decoded using information accompanying the content and that the decoding information is based on a user information of the user. Civanlar discloses and method and system of using personal information as a decryption key when distributing encrypted information (Abstract). Civanlar further teaches that the personal information is embedded in the purchased merchandise by the seller as a key and the purchased merchandise is forwarded to the buyer along with the key embedded therein. (Col. 2, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Dillon and include the ability to encrypt the content using a key which is based upon personal information of the user and transmitting this decoding information along with the content as taught by Civanlar. Civanlar provides motivation by indicating that this method provides strong security since the user would not be willing to reveal their key if its based upon something as personal as their credit card information or other personal information (Col. 3, lines 60-65).

As per **Claim 5**, Dillon further discloses wherein the contents mean a document displayed in a page unit (Col. 1, lines 55-65) and wherein the accounting is executed for the page unit (Col. 4, lines 16-20; Col. 7, lines 26-30).

As per **Claim 6**, Dillon further discloses wherein the distribution is executed by broadcast (Figure 1; Col. 3, lines 40-45).

As per **Claim 7**, Dillon discloses a contents distribution system that distributes digitized contents to plural users comprising:

- a distribution device that distributes encrypted contents (Figure 1; Col. 4, lines 1-20),

- a user terminal that receives encrypted contents distributed by the distribution device (Figure 1; Col. 4, lines 12-18; Col. 6, lines 60-67; Col. 9 line 65-Col. 10 line 6), selects at least one encrypted content from a catalog (Col. 4, lines 5-20) and generates accounting information according to the utilization of the selected encrypted content (Col. 4, lines 15-20; Col. 5, lines 43-50; Col. 6, lines 19-24; Col. 7, lines 26-38; Col. 8, lines 28-43), and
- a central station that collects and totalizes accounting information generated by the user terminal (Col. 4, lines 15-20; Col. 7, lines 26-38; Col. 8, lines 28-43).

Dillon, however, fails to explicitly disclose that the encrypted contents are first distributed to users and wherein the users can then select at least one of the encrypted content from the distributed contents. Dillon discloses that a catalog of available contents is distributed to the plural users and further wherein the users can then select the content that they wish to receive. However, It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Dillon and distribute the available contents to the user and further allow the user to select the contents he/she is interested in after reception of the contents. Dillon teaches that this method is not necessary since it would waste resources by requiring the user to receive content not of interest. The motivation would be to allow the user to determine which content he/she wishes to receive and charging the user for only the content that he/she receives without wasting resources by requiring the user to receive content not of interest (Col. 11 line 65-Col. 12 line 5).

Dillon further fails to explicitly disclose that the content is decoded using information accompanying the content and that the decoding information is based on a user information of the user. Civanlar discloses and method and system of using personal information as a decryption key when distributing encrypted information (Abstract). Civanlar further teaches that the personal information is embedded in the purchased merchandise by the seller as a key and the purchased merchandise is forwarded to the buyer along with the key embedded therein. (Col. 2, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Dillon and include the ability to encrypt the content using a key which is based upon personal information of the user and transmitting this decoding information along with the content as taught by Civanlar. Civanlar

provides motivation by indicating that this method provides strong security since the user would not be willing to reveal their key if its based upon something as personal as their credit card information or other personal information (Col. 3, lines 60-65).

As per **Claim 11**, Dillon further discloses wherein the distribution is executed by broadcast (Figure 1; Col. 3, lines 40-45).

7. Claims 4, 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon, U.S. Patent No. 5,727,065 and Civanlar, U.S. Patent No. 6,005,935 as applied above and further in view of Downs et al, U.S. Patent No. 6,226,618 B1.

As per **Claim 4**, Dillon discloses a contents distribution method including decoding of the encrypted contents before gaining access, however, the combination of Dillon and Civanlar fail to specifically disclose wherein the decoding is executed by a decoding key generated based upon first decoding information attached to the encrypted contents and second decoding information which is provided to the user. Downs et al disclose an electronic content delivery system for providing digital content in secure containers to a plurality of users and further teach encrypting/decrypting the secure container by executing a decoding technique wherein a decoding key is generated based upon first decoding information attached to the encrypted contents and second decoding information which is provided to the user (Col. 16, lines 21-53). It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and Civanlar and include a process of decrypting the encrypted content through the use of a decoding key which is generated based upon decoding information attached to the encrypted contents and decoding information which is provided to the user as taught by Downs et al. For example, Downs et al teaches a method to secure the distributed content wherein the sender encrypts a symmetric key with the recipient's public key and this information is transmitted along with the content. Downs et al further teaches that the recipient uses their private key to decrypt the encrypted symmetric key which is then used to decrypt the encrypted content. Therefore, the decoding key (symmetric key)

for decoding the encrypted content data is generated based upon decoding information attached to the content (recipient's public key) and decoding information provided to the user (recipient's private key). The well known motivation for using this type of encryption would be to secure the transmission of the content so that only authorized users are permitted to view the content.

As per **Claim 8**, Dillon discloses a contents distribution method including summary information showing a list and a summary of the available contents (Col. 4, lines 5-7 and 53-60; Col. 6, lines 12-24 and 35-41), however, the combination of Dillon and Civanlar fail to specifically disclose that the list and summary information is attached to the encrypted contents. Dillon teaches that the list and summary data is transmitted separately from the content data. Downs et al disclose an electronic content delivery system for providing digital content in secure containers to a plurality of users and further teach that list and summary information (Col. 9, lines 21-32) is included in the encrypted contents container (Col. 38 line 21-Col. 39 line 20). It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and Civanlar and include list and summary data attached to the encrypted content data in view of the teachings of Downs et al. One would have been motivated to include summary data with the content so that the user could refer to the list and summary data before purchasing the content to decide whether or not he/she desires the content. Dillon provides motivation by indicating that summary data is included such as a description of the content which would be sufficient to allow a user to determine whether he/she desires the document (Col. 6, lines 17-20).

As per **Claim 15**, Dillon discloses a contents distribution method wherein the distribution device attaches first decoding information required for decoding the encrypted contents to the encrypted contents and distributes them (Col. 6, lines 42-49), however, the combination of Dillon and Civanlar fail to specifically disclose wherein the user terminal is provided with second decoding information provided to the user and wherein the user decodes the encrypted contents based upon the first and second decoding information. Downs et al disclose an electronic content delivery system for providing digital content in secure containers to a plurality of users and further teach encrypting/decrypting the secure container by

executing a decoding technique wherein a decoding key is generated based upon first decoding information attached to the encrypted contents and second decoding information which is provided to the user (Col. 16, lines 21-53). It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and Civanlar and include a process of decrypting the encrypted content based upon decoding information attached to the encrypted contents and decoding information which is proper to the user as taught by Downs et al. For example, Downs et al teaches a method to secure the distributed content wherein the sender encrypts a symmetric key with the recipient's public key and this information is transmitted along with the content. Downs et al further teaches that the recipient uses their private key to decrypt the encrypted symmetric key which is then used to decrypt the encrypted content. Therefore, the decoding key (symmetric key) for decoding the encrypted content data is generated based upon decoding information attached to the content (recipient's public key) and decoding information proper to the user (recipient's private key). The well known motivation for using this type of encryption would be to secure the transmission of the content so that only authorized users are permitted to view the content.

8. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon, U.S. Patent No. 5,727,065 and Civanlar, U.S. Patent No. 6,005,935 as applied above and in further view of Stefik et al, U.S. Patent No. 5,634,012.

As per **Claims 12 and 13**, Dillon discloses a contents distribution system wherein the user terminal comprises:

- a data sink that receives encrypted contents distributed from the distribution device (Col. 2, lines 10-15; Col. 6, lines 60-65),
- a data output part that decodes the encrypted contents (Col. 2, lines 10-15; Col. 4, lines 15-20; Col. 6 line 64-Col. 7 line 5) and generates accounting information according to the quantity of utilized decoded contents (Col. 4, lines 15-20; Col. 5, lines 43-50; Col. 6, lines 19-24; Col. 7, lines 26-38; Col. 8, lines 28-43)

Dillon and Civanlar fail to specifically disclose that the user terminal stores the encrypted contents distributed from the distribution device, but Dillon discloses that the user terminal decrypts the encrypted content as it is being received and only stores the decrypted contents. However, it would have been obvious to one of ordinary skill in the art to modify this method and receive and store the content in its encrypted form and then decrypt the content after it has been stored. The motivation would be to provide a faster and more efficient transmission technique since the content would not need to be decrypted in real time as it is being received, but rather decrypted only when the user is ready to view the information.

Dillon and Civanlar further fail to specifically disclose a printer that prints the contents. Stefik et al disclose a system for controlling the distribution and use of digital information and teach wherein a printer is used to print a certain number of copies of the decoded information (Col. 38, lines 21-62) and performs closing transaction steps including initiating a charging transaction based upon the quantity of the utilized contents (Col. 33, lines 48-59). It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and Civanlar and incorporate the ability to not only display the decoded content, but also print the decoded content and charge a fee for printing of the document as taught by Stefik et al. The motivation would be to provide the convenience to the user of having the ability to render the digital content by using a printer so that it could be carried in hardcopy form. It also would provide a benefit to the content provider by allowing the content provider to charge a fee for printing the content as taught by Stefik et al.

As per **Claim 14**, Dillon discloses a contents distribution system wherein the user terminal comprises:

- a data sink that receives encrypted contents distributed from the distribution device (Col. 2, lines 10-15; Col. 6, lines 60-65),
- a display that decodes the encrypted contents and displays the contents (Col. 1, lines 60-65; Col. 2, lines 10-15; Col. 4, lines 15-20; Col. 6 line 64-Col. 7 line 5) and generates accounting information according to the quantity of utilized decoded contents (Col. 4, lines 15-20; Col. 5, lines 43-50; Col. 6, lines 19-24; Col. 7, lines 26-38; Col. 8, lines 28-43)

Dillon and Civanlar fail to specifically disclose that the user terminal stores the encrypted contents distributed from the distribution device, but Dillon discloses that the user terminal decrypts the encrypted content as it is being received and only stores the decrypted contents. However, it would have been obvious to one of ordinary skill in the art to modify this method and receive and store the content in its encrypted form and then decrypt the content after it has been stored. The motivation would be to provide a faster and more efficient transmission technique since the content would not need to be decrypted in real time as it is being received, but rather decrypted only when the user is ready to view the information.

Dillon also discloses that the content includes text, software, images and full-motion video, however, further Dillon and Civanlar fail to specifically disclose displaying the contents and generating accounting information specifically according to the number of pages included in the displayed contents. Stefik et al disclose a system for controlling the distribution and use of digital information and teach wherein the user device is used to display the digital contents such as rendering it for reading (Col. 37, lines 60-67) and performs closing transaction steps including initiating a charging transaction based upon the quantity of the utilized contents (Col. 38, lines 19-21; Col. 33, lines 48-59). It would have been obvious to one of ordinary skill in the art to modify the method of Dillon and Civanlar and incorporate the ability to not only display the decoded content, but also print the decoded content and charge a fee for displaying or printing of the document based upon the number of pages in the content as taught by Stefik et al. The motivation would be to permit the user to display the received content thereby making it useful. It also would provide a benefit to the content provider by allowing the content provider to charge a fee for displaying the content as taught by Stefik et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Steinberg et al disclose a software fingerprinting and branding method wherein the content is decoded using key information which is only known by the user and wherein identification of the user is embedded in the encoding program. The user is not given access unless the user provides the key along with identification data.

- Yuval et al disclose a method for controlling unauthorized access to information distributed to users and teach that the information is decoded using keys that are based upon user information such as name, credit card number, etc.
- Chou et al disclose a method of software distribution protection using a key that relies upon a unique factor such as a serial number or profile or fingerprint of the users computer.

10. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Saito discloses a secure data broadcasting system wherein encrypted content is broadcast to users that decode the information
- Kazmierczak et al disclose a cryptographic system for effecting metered purchases of encrypted data for a local encrypted database
- Peterson, Jr. discloses a system for distribution of secured content wherein the user decrypts the content and is available for viewing during a certain timeframe
- Ginter et al disclose a system and method for secure transaction management wherein content is distributed to users and assigned certain rights for accessing the data
- Choy discloses the distribution of content to users wherein a protection specification including information for controlling the use of the content is attached to the content and transported together
- Kocher et al disclose a secure cryptographic rights unit for cryptographically regulating access to digital content distributed over a network
- WO 90/02382 discloses an information distribution system that provides encrypted information to a user that corresponds to criteria individually selected by the user and then charges the user only for the selected information provided
- Thyfault, Mary E., "Data From Above", discloses a satellite service that broadcasts encrypted information to users and are charged for the amount of information downloaded.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-5531 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-7687 (for formal communications intended for entry including After-Final communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John Hayes

Examiner

30 October 2002